#16 Appeal Brief 4/8/04

PATENT

Attorney Docket No. 23452-088

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT :	Quinton Yves Zondervan	CONFIRMATION NO.:	5720
SERIAL NO. :	09/481,512	EXAMINER :	Vernal U. Brown
FILING DATE :	January 12, 2000	ART UNIT :	2635
FOR :	SYSTEM AND METHOD FOR FORMATTING AN ELECTRONIC MESSAGE		

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Appellant's Brief On Appeal Under 37 C.F.R. §1.192

Sir:

Further to the Notice of Appeal filed on December 1, 2003, Appellant's herewith submit Appellant's Brief on Appeal in triplicate pursuant to 37 C.F.R. §1.192(a).

It is not believed that extensions of time or fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0311 (*Ref. No. 23452-088*).

(1) REAL PARTY IN INTEREST

By virtue of the assignment recorded May 22, 2000 at reel 010836, frame 0159, the real party in interest is **International Business Machines** Corporation, a New York corporation having a place of business in Armonk, New York.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF THE CLAIMS

Claims 9, 12, 14, and 21-47 are pending in the case. Claims 9, 12, and 46-47 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9, 12, 14, and 21-46 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,742,905 to Pepe et al. ("Pepe"). Claim 47 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Pepe in view of U.S. Patent No. 6,223,213 to Cleron et al. ("Cleron"). Appellant appeals the rejections of claims 9, 12, 14, and 21-47.

(4) STATUS OF AMENDMENTS

Appellant submits herewith an amendment to claim 46 to comply with §112 formalities indicated by the Examiner on page 3 of the July 30, 2003 Office Action. Appellant submits that this amendment reduces the number of issues for appeal and requests that this amendment be entered. Appendix A reflects this amendment to claim 46 with the changes noted.

(5) SUMMARY OF THE INVENTION

Various embodiments of Appellant's invention relate to providing a seamless distribution of messages to and from recipients and senders utilizing different communication devices. In one embodiment, a sender sends an e-mail message to a

recipient via a standard e-mail system, a server embodying various features of the present invention acts based on instructions received from the intended recipient and translates the e-mail message, or composes a message therefrom, in accordance with further instructions and forwards the translated message to the recipients' two way pager device where the message is received. The recipient may then, utilizing the two way wireless terminal device, respond to the message by forwarding a reply message to the sender, forwarding the original message to one or more third parties, deleting the message, storing the message, or taking some other action. (*See* Specification page 3, lines 10-21).

Should the recipient elect to send a reply message to the sender directly from the two-way terminal device, a server of the present invention receives the reply and modifies that reply. For example, in various embodiments of the invention, the system may add a header, a footer, and page formatting or make other changes in the presentation format of the message in accordance with a template residing on the server. The original sender, now the reply recipient, receives the message. In one embodiment, this reply message now has the appearance of having come directly from a typical e-mail transmitting device, such as a computer terminal, rather than having come from a wireless terminal device, such as a pager. (*See* Specification page 3, line 22- page 4, line 6).

(6) ISSUES

1.   Whether the use of "receiving the electronic message..." in claims 9, 12, and 46-47 render the claims indefinite and unpatentable under 35 U.S.C. §112, second paragraph.

2.   Whether claims 9, 12, 14, and 21-46 are anticipated under 35 U.S.C. §102(b) by Pepe.

(7) GROUPING OF CLAIMS

Claims 9, 12, 14, and 21-47 are separately patentable. However, Appellant has grouped claims that include similar features. In particular, Appellant requests that

claims 9, 12, 14, and 41 be considered to stand and fall together; that claims 21, 22, 26, and 30-33 be considered to stand and fall together; that claim 23 be considered to stand and fall alone; that claim 24 be considered to stand and fall alone; that claims 25 and 38 be considered to stand and fall together; that claims 27 and 42 be considered to stand and fall together; that claims 28 and 43-45 be considered to stand and fall together; that claims 29 and 39 be considered to stand and fall together; that claim 34 be considered to stand and fall alone; that claims 35 and 36 be considered to stand and fall together; that claim 37 be considered to stand and fall alone; that claim 40 be considered to stand and fall alone; and that claims 46 and 47 be considered to stand and fall together.

(8) ARGUMENT

For issue 1, the question to be resolved is whether the claim element of "receiving the electronic message..." renders the claim indefinite. Appellant submits that the claim element "receiving an electronic message from the first terminal device" does not render the claims indefinite, because one of ordinary skill in the art would understand the meaning of this claim element in light of Appellant's specification.

For issue 2, the question to be resolved is whether Pepe anticipates claims 9, 12, 14, and 21-46, under 35 U.S.C. §102(b). Appellant submits that the asserted rejection is improper for at least falling to anticipate all the claim elements. Appellants provide below a discussion of the requirements for anticipation under 35 U.S.C. §102(b) and an application of these requirements to each rejected claim.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 9, 12, and 46-47 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appellant respectfully submits that this rejection is improper for the following reasons.

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The Examiner alleges that claims 9, 12, and 46-47 are indefinite because "it is not clear what is receiving the electronic message from the first device". (*See* page 3, "Claim Rejections – 35 USC § 112" of the July 30, 2003 Office Action).

The objective requirement of §112, second paragraph, is evaluated in the context of whether the claim is definite—i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. (*See* M.P.E.P. 2171).

Appellant submits that "receiving an electronic message from the first terminal device" in the context of communications software applications would be well within the understanding of one of ordinary skill in the art. Contrary to the Examiner's implication, Appellant need not specify a particular device that actually performs this step of the claim. Accordingly, the rejection of claims 9, 12, 46, and 47 must be withdrawn

Rejections Under 35 U.S.C. §102(b) as Allegedly Anticipated by Pepe

Requirements for anticipation

As set forth in the MPEP § 2131, a claim is anticipated only if each element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent Claims 9 and 14 and Dependent Claims 12, and 41

Appellant respectfully submits that the rejection of claims 9, 12, 14, and 21-46 under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe is improper for at least failing to disclose all the claim elements.

Claim 9 includes the features of "modifying a presentation format of the electronic message from the first message presentation format to a modified message presentation format" and "sending the electronic message in the modified message

presentation format to the second terminal device." At least these features are not disclosed by Pepe.

Apparently, the Examiner relies on Figures 1 and 3 in Pepe to disclose these features. Appellant submits that Pepe, as illustrated in Figures 1 and 3, discloses a networked system of multiple electronic devices where an electronic message can be transmitted from one type of device and delivered to another type of device. Col. 6, lines 3-5 of Pepe states: "The PCI 40 will perform a media conversion to allow, for instance, an e-mail message to be delivered to a fax server."

Thus, it appears that the device in Pepe transmits a message in a format germane to the device to the PCI database, which in turn, performs a "media conversion" (or what Appellants have referred to as a "delivery format conversion") and then delivers the message to the intended destination device. At best, Pepe discloses modifying the delivery format of the electronic message from one type of device to another type of device to facilitate delivery of the message. However, Pepe does not disclose modifying a presentation format of the electronic message and sending or transmitting the electronic message in the modified presentation format.

Appellant submits that modifying a delivery format of a message is entirely different from modifying a message presentation format as these occur at different layers in the communication channel. For at least this reason, Pepe does not anticipate claim 9.

Furthermore, Appellant submits that Pepe does not disclose that the modified message presentation format is other than the first message presentation format. Because Pepe only discloses modifying the delivery format, and does not disclose modifying the presentation format, the appearance of the message sent from a first device to a second device in Pepe would always be consistent with that from any other similar first device during the delivery process. In other words, in Pepe, the message would arrive at its destination (i.e., the second device) in a presentation format consistent with that from other first devices sending messages to the second device. Therefore, the electronic message would appear to have been sent from the first terminal device even though the delivery format was changed.

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However, claim 9 requires that the modified message presentation format be other that than of the first presentation format. As set forth above, Pepe does not disclose this aspect of the invention. For at least this additional reason, Pepe does not anticipate claim 9

Claim 14 includes features similar to those in claim 9 and is not anticipated by Pepe for at least the same reasons.

Claims 12 and 38-45 depend from and add additional features to independent claim 9. Because Pepe does not disclose each of the features included in claim 9, dependent claims 12 and 38-45 are not anticipated by Pepe, at least by virtue of their dependency.

Independent Claim 21 and Dependent Claims 22, 26, and 30-33

Claim 21 includes, *inter alia,* an integrated messaging system that "modifies a presentation format of the electronic message from the first message presentation format to a modified message presentation format" and "sends the electronic message in the modified message presentation format to the second terminal device." At least these features are not disclosed by Pepe.

Apparently, the Examiner relies on Figures 1 and 3 in Pepe to disclose these features. Appellant respectfully submits that Pepe, as illustrated in Figures 1 and 3, discloses a networked system of multiple electronic devices where an electronic message can be transmitted from one device and delivered to the another device. Col. 6, lines 3-5 of Pepe states: "The PCI 40 will perform a media conversion to allow, for instance, an e-mail message to be delivered to a fax server."

Thus, it appears that the device in Pepe transmits a message in a format germane to the device to the PCI database, which in turn performs a media conversion (*i.e.*, a delivery format conversion) and then delivers the message to the intended destination device. At best, Pepe discloses modifying a delivery format of the electronic message from one type of device to another type of device to facilitate delivery of the message. However, Pepe does not disclose modifying a presentation format of the

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electronic message and sending or transmitting the electronic message in the modified presentation format.

Appellant submits that modifying a delivery format of a message is entirely different from modifying a message presentation format as these occur at different layers in the communication channel. For at least this reason, Pepe does not anticipate claim 21.

Claims 22, 26, and 30-33 depend from and add additional features to independent claim 21. Because Pepe does not disclose each of the features included in claim 21, dependent claims 22, 26, and 30-33 are not anticipated by Pepe.

Dependent Claim 23

Claim 23 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in the independent claim 21 and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claim 23 is not anticipated by Pepe at least by virtue of its dependency.

Furthermore, claim 23 includes, *inter alia,* the feature of "wherein said modified message presentation format is other than said second message presentation format." At least this additional feature is not disclosed by Pepe.

Apparently, the Examiner relies on sending messages, as illustrated in Figure 1 of Pepe, from one type of device such as a fax machine to another type of device such as a pager, to disclose these features. According to Pepe, the fax machine delivery format (*i.e.*, first format) is converted to the pager delivery format (*i.e.*, second format). According to the Examiner, Pepe apparently teaches that the modified message presentation format is the second message presentation format.

However, this interpretation of Pepe is inconsistent with Appellant's claim language. Dependent claim 23 recites that the message presentation format be "other that the second message presentation format." For at least this reason, claim 23 is not anticipated by Pepe.

Dependent Claim 24

Claim 24 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in the independent claim 21 and dependent claim 22 and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claim 24 is not anticipated by Pepe at least by virtue of its dependency.

Furthermore, claim 24 includes, *inter alia,* the feature of "said modified message presentation format is other than said first message presentation format" and "said modified message presentation format is other than said second message presentation format." At least these additional features is not disclosed by Pepe.

Apparently, the Examiner relies on sending messages, as illustrated in Figure 1 of Pepe, from one type of device such as a fax machine to another type of device such as a pager, to disclose these features. According to Pepe, the fax machine delivery format (*i.e.*, first format) is converted to the pager delivery format (*i.e.*, second format).

According to the Examiner, Pepe apparently teaches that the modified message presentation format corresponds to the second message presentation format. It may also be possible that the Examiner is interpreting the modified message presentation format to correspond to the first message presentation format as well or in the alternative.

However, either of these interpretations are inconsistent with Appellant's claim language. Claim 24 requires that the message presentation format be "other than the first message presentation format" and "other than the second message presentation format." Pepe does not disclose these features. For at least this additional reason, claim 24 is not anticipated by Pepe.

Dependent Claims 25 and 38

Claims 25 and 38 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in the independent claims 9 and 21 and thus, necessarily fails to disclose the features of

these dependent claims. Therefore, Appellant respectfully submits that claims 25 and 38 are not anticipated by Pepe at least by virtue of their dependency.

Furthermore, claims 25 and 38 include, *inter alia,* the feature of "said modified message presentation format is specified by a user of said first terminal device." At least this feature is not disclosed by Pepe.

Apparently, the Examiner relies on the references in Pepe to delivery of outgoing messages and routing of incoming messages based on a subscriber's profile to disclose this feature. (See col. 6, lines 23-29 of Pepe). Col. 6, lines 21-29 of Pepe states:

> "As shown in FIG. 2 a subscriber provides the network with message routing and delivery instructions. These instructions are received by a PCI database 44 and stored in a 'subscriber profile' for that subscriber. This database controls the delivery of outgoing messages and the routing of incoming messages and message notification."

Appellant submits that Pepe's "routing and delivery instructions" specified by the subscriber are not presentation formats. Rather, these "routing and delivery instructions" control the subscriber's choice of message destinations. Pepe is silent with regard to user-specified presentation formats and modifying messages in accordance with them. Thus, Pepe does not disclose at least this feature of claims 25 and 38. For at least this additional reason, claim 25 and 38 are not anticipated by Pepe.

Dependent Claims 27 and 42

Claims 27 and 42 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in the independent claim 9 and 21 and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claims 27 and 42 are not anticipated by Pepe at least by virtue of their dependency.

Furthermore, claims 27 and 42 include, *inter alia,* the feature of "said modified message presentation format corresponds to a type of terminal device other than said

first terminal device and said second terminal device." At least this feature is not disclosed by Pepe.

Apparently, the Examiner relies on transmitting messages, as illustrated in Figure 1 of Pepe, from one type of device to a different type of device to disclose these features.

According to the Examiner, Pepe apparently teaches that the modified message presentation format corresponds to a format of the second terminal device. It may also be possible that the Examiner is interpreting the modified message presentation format to correspond to a format of the first terminal device as well or in the alternative.

However, dependent claim 27 requires that the message presentation format corresponds to a type of device other than the first terminal device and other than the second terminal device. Thus, Pepe does not disclose these additional features of dependent claim 27. Dependent claim 42 was not addressed in the Office Action of July 30, 2003, but nonetheless has similar features to claim 27 and is similarly not anticipated by Pepe. For at least these reasons, claims 27 and 42 are not anticipated by Pepe.

Dependent Claims 28 and 43-45

Claims 28 and 43 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in independent claims 9 and 21, and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claims 28 and 43 are not anticipated by Pepe at least by virtue of their dependency.

Furthermore, claims 28 and 43 include, *inter alia,* the feature of "said electronic message appears to have been sent to said second terminal device from a type of terminal device other than said first terminal device." At least this feature is not disclosed by Pepe.

Apparently, the Examiner relies on Figures 1 and 3 in Pepe to disclose these features. Appellant respectfully submits that Pepe, as illustrated in Figures 1 and 3,

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discloses a networked system of multiple electronic devices where an electronic message can be transmitted from one type of device to another type of device. Col. 6, lines 3-5 of Pepe states: "The PCI 40 will perform a media conversion to allow, for instance, an e-mail message to be delivered to a fax server."

At best, Pepe discloses modifying the delivery format of the electronic message from one type of device to another type of device to facilitate delivery of the mesasge. Because Pepe only discloses modifying the delivery format, and does not disclose modifying the presentation format, the appearance of the message at the second device would be consistent with having come from the first device. In other words, the electronic message would appear to have been sent from the first terminal device.

Appellant submits that Pepe does not disclose that the electronic message appears to have been sent to the second terminal device from a type of terminal device other than said first terminal device.

Even if, *assuming arguendo*, the presentation format is inherently modified because of the underlying conversion in the delivery format disclosed in Pepe, Pepe does not disclose that the electronic message appears to have been sent to said second terminal device from a type of terminal device other than said first terminal device. According to Pepe, an e-mail delivered to a fax will always appear as an e-mail delivered to a fax when it is received at the fax server. Thus, a user receiving a fax in Pepe would be able to identify e-mail as the source of the message.

However, claim 28 includes modifying the presentation format in order to make the electronic message appear to have been sent to said second terminal device from a type of terminal device other than said first terminal device. Pepe does not disclose the that the electronic message appears to have been sent to said second terminal device from a type of terminal device other than said first terminal device. For at least this additional reason, Pepe does not anticipate claims 28 and 43. Dependent claims 44 and 45 depend from claim 43 and add features; therefore they are not anticipated by Pepe at least by virtue of their dependency.

Dependent Claims 29 and 39

Claims 29 and 39 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in independent claims 9 and 12, and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claims 29 and 39 are not anticipated by Pepe at least by virtue of their dependency.

Furthermore, claims 29 and 39 include, *inter alia,* the feature of "wherein said modified message presentation format is specified by a user of said second terminal device." At least this feature is not disclosed by Pepe.

Apparently, the Examiner relies on the references in Pepe to delivery of incoming messages based on a subscriber's profile to this feature. (See col. 6, lines 25-27 of Pepe). Pepe's subscriber profile "controls the delivery of outgoing messages and the routing of incoming messages." (see col. 6, lines 25-27 of Pepe). The PCI database controls the delivery of outgoing messages and the routing of incoming messages and message notification based on the instructions in the subscriber profile. (see col. 6, lines 25-27 of Pepe).

Appellant submits that Pepe's "routing and delivery instructions" specified by the subscriber are not presentation formats. Rather, these "routing and delivery instructions" control the subscriber's choice of message destinations. Pepe is silent with regard to modifying the message presentation format based on presentation formats for the user receiving the message. Thus, Pepe does not disclose at least this feature of claims 29 and 39. For at least this additional reason, claim 29 and 39 are not anticipated by Pepe.

Dependent Claim 34

Claim 34 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in the claims 21, 32, and 33 and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claim 34 is also not anticipated by Pepe at least by virtue of its dependency.

Furthermore, claim 34 includes, *inter alia,* the feature of "wherein said scripting agent modifies the presentation format of the electronic message to said second terminal device by adding at least one of a signature block, a header, and a footer." At least these features are not disclosed by Pepe.

The Examiner maintains the position that: "Pepe et al. further teaches the use of header information to send notification message to the subscriber (col. 27, lines 43-45)." (*See* page 6, bottom of the July 30, 2003 Office Action). Col. 27, lines 43-45 of Pepe states:

> "The PCI server 48, however, has header information needed to send a notification message to the subscriber, if such notification is required by the subscriber."

The portion immediately above the portion relied upon by the Examiner (*i.e.*, lines 29-43), states:

> "The PCI voice messaging call flow is as follows. Using the AMIS-Analog Protocol the system originating the voice message sends message information to the PCI server 48 specifying the type of message to be delivered, the message length (in minutes), the originators mailbox number, and the recipients mailbox number. When the message arrives at the PCI server 48, the originator's mailbox is extracted from AMIS-Analog protocol and is compared to the subscriber's voice mailbox number stored in the subscriber profile. If the two values match, the voice message is already in the mailbox designated by the subscriber. In this case, the PCI server sends a bogus error code to the originating voice messaging system using the AMIS-Analog protocol so that the voice message is rejected and is not forwarded to the PCI server.... "

Taken in proper context, then Pepe merely discloses sending the portion of a packet preceding the actual data for the purpose of error checking and notification. Appellants submits that the portion of Pepe relied upon to reject this claim deals with delivery protocols rather than presentation formats. Pepe deals with headers in the context of data packet communication technology; whereas Appellant's invention is concerned with how a header becomes part of the format of a message. Moreover, Pepe's header information is not equivalent to Appellant's presentation header.

Therefore, Pepe does not modify "the presentation format of the electronic

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message to said second terminal device by adding at least one of a signature block, a header, and a footer" as set forth in Appellant's specification at, for example, specification page 4, lines 1-6. For at least this additional reason, Appellant submits that claim 34 is not anticipated by Pepe.

Dependent Claims 35 and 36

Claim 35 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in independent claim 21, and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant respectfully submits that claim 35 is not anticipated by Pepe at least by virtue of its dependency.

Furthermore, claim 35 includes, *inter alia,* the features of "wherein the modified presentation format of the electronic message received by said second terminal device is the same as a presentation format of an electronic message sent by said second terminal device and received by said first terminal device." At least these features are not disclosed by Pepe.

The Examiner maintains that "Pepe et al. teaches the user selects the formats used for delivering messages (col. 6,lines 1-3). The presentation format of the received electronic message is therefore allowed to be of the same format as that of the sending device." (*See* page 6, bottom of the July 30, 2003 Office Action). However, col. 6, lines 1-3 of Pepe states:

> "The subscriber selects the wireline or wireless network and media format to be used for delivering messages or notification of the message receipt."

This cited portion of Pepe simply does not support the Examiner's position. The claim recites that the "modified presentation format of the electronic message received by said second terminal device is the same as a presentation format of an electronic message sent by said second terminal device and received by said first terminal device." Pepe does not disclose this feature.

At best, Pepe discloses transmitting a message from a mobile device to an office

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device, or vice versa, wherein the system selects a delivery format. For at least this additional reason, Appellant submits that claim 35 is not anticipated by Pepe. Claim 36 depends from and adds additional features to claim 35, and is therefore patentable for at least the same reasons.

Independent Claim 37

Claim 37 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. Claim 37 includes, *inter alia,* the features of "a module that modifies a format of said first electronic message from the first presentation format, wherein said modified message presentation format is specified by one of a user of the first terminal device or a user of the second terminal device" and "a module that sends said electronic message in said modified message presentation formation to the second terminal device." At least these features are not disclosed by Pepe.

Apparently, the Examiner relies on Figures 1 and 3 in Pepe to disclose these features. Appellant submits that Pepe, as illustrated in Figures 1 and 3, discloses a networked system of multiple electronic devices where an electronic message can be transmitted from one device and delivered to the another device. Additionally, col. 6, lines 3-5 of Pepe states: "The PCI 40 will perform a media conversion to allow, for instance, an e-mail message to be delivered to a fax server."

Thus, at best, Pepe discloses modifying a delivery format of an electronic message from one type of device to another type of device. However, Pepe does not disclose modifying a presentation format of an electronic message and sending or transmitting the electronic message in the modified presentation format.

Appellant respectfully submits that modifying a delivery format of a message is entirely different from modifying a message presentation format as these occur at different layers of the communication channel. For at least this additional reason, Appellant submits that claim 37 is not anticipated by Pepe.

Dependent claims 38-45 depend from and add additional features to independent claim 37. Because Pepe does not disclose each of the features recited in claim 37, Appellant respectfully submits that dependent claims 38-45 are also

patentable for at least the foregoing reasons.

Dependent Claim 40

Claim 40 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. As set forth above, Pepe fails to disclose each of the features in independent claim 9, and thus, necessarily fails to disclose the features of the dependent claims. Therefore, Appellant submits that claim 40 is also not anticipated by Pepe at least by virtue of its dependency.

Furthermore, claim 40 includes, *inter alia,* the features of "the modified message presentation format is other than the second message presentation format." At least this feature is not disclosed by Pepe.

Apparently, the Examiner relies on transmitting messages, as illustrated in Figure 1 of Pepe, from one type of device to a different type of device to disclose these features. According to the Examiner, Pepe apparently teaches that the modified message presentation format corresponds to a format of the second terminal device.

However, dependent claim 27 requires that the message presentation format corresponds to a presentation format other than that of the second terminal device. Pepe does not disclose this additional feature of dependent claim 40. For at least this additional reason, claim 40 is not anticipated by Pepe.

Independent Claim 46 and Dependent Claim 47

Claim 46 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Pepe. Claim 46 includes, *inter alia,* the features of "modifying a presentation format of the electronic message from the first message presentation format to a modified message presentation format," "modifying a delivery format of the electronic message from the first message delivery format to the second message delivery format," and "transmitting the electronic message in the modified message presentation format and in the second message delivery format to the second terminal device." At least these features are not disclosed by Pepe.

The Examiner maintains the position that:

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"Pepe teaches receiving an electronic message from a first terminal device and modifying the message from the first message presentation format to a modified message presentation format and send the modified message presentation format to the second terminal device by carrying out media conversion (col. 6, lines 3-5) and (col. 6, lines 11-14). The terminal device further inherently receive [sic] and transmit [sic] messages in the same format (e.g. a fax machine receive messages in a fax format and transmit messages in a fax format)." (*See* page 8, 1st full paragraph of the July 30, 2003 Office Action).

Appellant submits the cited figure and passages from Pepe do not support the Examiner's position.

Pepe, as illustrated in Figures 1 and 3, discloses a networked system of multiple electronic devices where an electronic message can be transmitted from one type of device and delivered to another type of device. Additionally, Pepe col. 6, lines 3-5 on which the Examiner relies states: "The PCI 40 will perform a media conversion to allow, for instance, an e-mail message to be delivered to a fax server."

Thus, as set forth at length above, Pepe does not disclose modifying a presentation format of a message. The Examiner relies on the portions of Pepe that apparently disclose modifying a delivery format of the message. To the extent that claim 46 requires modification of both the delivery format and the presentation format of the message, the Examiner can no longer rely on the former to disclose the latter.

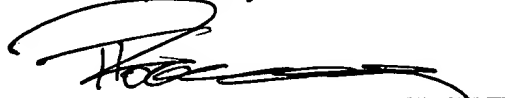Accordingly, Appellant submits that claim 46 is not anticipated by Pepe for at least the foregoing reasons.

The Examiner has rejected claim 47 as unpatentable over Pepe in view of Cleron. Cleron does not address the deficiencies of the Pepe set forth above with regard to claim 46. Accordingly, because claim 47 depends from and adds additional features to independent claim 46, claim 47 is patentable for at least the same reasons.

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Conclusion

Because the references relied upon by the Examiner, either alone or in combination with one another, fail to disclose, teach or suggest all of the features of the claims as set forth above, Appellants respectfully request that the rejection of each of pending claims 9, 12, 14, and 21-47 under 35 U.S.C. §112, and 35 U.S.C. §102 be reversed.

Dated: <u>April 1, 2004</u>

Respectfully submitted,

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APPENDIX A—PENDING CLAIMS

LISTING OF CLAIMS:

1 - 8. **(Cancelled)**

9. **(Previously Presented)** A method for managing communications of electronic messages between a first terminal device and a second terminal device, wherein the first terminal device has a first message presentation format and the second terminal device has a second message presentation format, the method comprising:

receiving an electronic message from the first terminal device, said electronic message in the first message presentation format;

modifying a presentation format of the electronic message from the first message presentation format to a modified message presentation format; and sending the electronic message in the modified message presentation format to the second terminal device,

wherein the modified message presentation format is other than the first message presentation format.

10 and 11. **(Cancelled)**.

12. **(Previously Presented)** The method of claim 9, wherein said modifying comprises:

accessing a user profile; and

determining a modified message presentation format based on the user profile and the second message presentation format.

13. **(Cancelled)**.

14.   **(Previously Presented)** A computer usable medium having computer readable program code embodied therein for managing communications of electronic messages between a first terminal device and a second terminal device, wherein the first terminal device has a first message presentation format and the second terminal device has a second message presentation format, the computer readable code comprising:

computer code for causing a computer system to receive an electronic message from the first terminal device, the electronic message in the first message presentation format;

computer code for causing a computer system to modify a presentation format of the electronic message from the first message presentation format to a modified message presentation format; and

computer code for causing a computer system to send the electronic message in the modified message presentation format to the second terminal device, wherein the modified message presentation format is other than the first message presentation format.

15 – 20.   **(Cancelled)**.

21.   **(Previously Presented)** An integrated messaging system comprising:
a first terminal device that transmits and receives electronic messages in a first message presentation format;

a second terminal device that transmits and receives electronic messages in a second message presentation format;
a server system, coupling said first terminal device with said second terminal device, that receives an electronic message from said first terminal device, that modifies a presentation format of the electronic message from the first message presentation format to a modified message presentation format, and that sends the electronic message in the modified message presentation format to said second terminal device.

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22.   **(Previously Presented)** The system of claim 21, wherein said modified message presentation format is other than said first message presentation format.

23.   **(Previously Presented)** The system of claim 21, wherein said modified message presentation format is other than said second message presentation format.

24.   **(Previously Presented)** The system of claim 22, wherein said modified message presentation format is other than said second message presentation format.

25.   **(Previously Presented)** The system of claim 21, wherein said modified message presentation format is specified by a user of said first terminal device.

26.   **(Previously Presented)** The system of claim 21, wherein said modified message presentation format corresponds to a type of terminal device other than said first terminal device.

27.   **(Previously Presented)** The system of claim 21, wherein said modified message presentation format corresponds to a type of terminal device other than said first terminal device and said second terminal device.

28.   **(Previously Presented)** The system of claim 21, wherein said electronic message appears to have been sent to said second terminal device from a type of terminal device other than said first terminal device.

29.   **(Previously Presented)** The system of claim 21, wherein said modified message presentation format is specified by a user of said second terminal device.

30.   **(Previously Presented)** The system of claim 21, wherein the first terminal device is a wireless terminal device.

31.   **(Previously Presented)** The system of claim 30, wherein the wireless terminal device is a pager.

32.   **(Previously Presented)** The system of claim 21, wherein said server system includes a scripting agent that modifies the presentation format of the electronic message from the first message presentation format to a modified message presentation format by performing a summary function on the electronic message.

33.   **(Previously Presented)** The system of claim 32, wherein said server system includes at least one user profile and a scripting agent, wherein said scripting agent modifies the presentation format of the electronic message to said second terminal device in accordance with said user profile, and wherein said scripting agent modifies a presentation format of an electronic message from said second terminal device to said first terminal device in accordance with said user profile.

34.   **(Previously Presented)** The system of claim 33, wherein said scripting agent modifies the presentation format of the electronic message to said second terminal device by adding at least one of a signature block, a header, and a footer.

35.   **(Previously Presented)** The system of claim 21, wherein the modified presentation format of the electronic message received by said second terminal device is the same as a presentation format of an electronic message sent by said second terminal device and received by said first terminal device.

36.   **(Previously Presented)** The system of claim 35, further comprising a scripting agent that performs a summary function on the electronic message sent by said second terminal device prior to transmitting the electronic message to said first terminal device.

37.   **(Previously Presented)** A server system operable in an integrated messaging system for facilitating communications between a first terminal device and a second terminal device, the server system comprising:

a module that receives an electronic message from the first terminal device, said electronic message having a first message presentation format;

a module that modifies a format of said electronic message from the first presentation format to a modified message presentation format, wherein said modified message presentation format is specified by one of a user of the first terminal device or a user of the second terminal device; and

a module that sends said electronic message in said modified message presentation formation to the second terminal device.

38.   **(Previously Presented)** The method of claim 9, wherein said modified message presentation format is specified by a user of the first terminal device.

39.   **(Previously Presented)** The method of claim 9, wherein said modified message presentation format is specified by a user of the second terminal device.

40.   **(Previously Presented)** The method of claim 9, wherein said modified message presentation format is other than the second message presentation format.

41.   **(Previously Presented)** The method of claim 9, wherein said modified message presentation format corresponds to a type of terminal device other than said first terminal device.

42.   **(Previously Presented)** The method of claim 9, wherein said modified message presentation format corresponds to a type of terminal device other than said first terminal device or said second terminal device.

43.   **(Previously Presented)** The method of claim 9, wherein said electronic message appears to have been sent to said second terminal device from a type of terminal device other than said first terminal device.

44.   **(Previously Presented)** The integrated messaging method of claim 43, wherein the first terminal device is a wireless terminal device.

45.   **(Previously Presented)** The integrated message method of claim 44, wherein the wireless terminal device is a pager.

46.   **(Currently Amended, Not Yet Entered)** A method for managing communications of electronic messages between a first terminal device and a second terminal device, wherein the first terminal device has a first message delivery format and a first message presentation format and the second terminal device has a second message delivery format and a second message presentation format, wherein ~~the~~ electronic messages are ~~can be~~ delivered to and from the first terminal device in the first message delivery format, and wherein ~~the~~ electronic messages are ~~can be~~ delivered to and from the second terminal device in the second message delivery format, the method comprising:

receiving an electronic message from the first terminal device, said electronic message in the first message presentation format and the first message delivery format;

modifying a presentation format of the electronic message from the first message presentation format to a modified message presentation format;

modifying a delivery format of the electronic message from the first message delivery format to the second message delivery format; and

transmitting the electronic message in the modified message presentation format and in the second message delivery format to the second terminal device,

wherein the modified message presentation format is other than the first message presentation format.

47.   **(Previously Presented)** A method of claim 46, wherein at least one of the first and second terminal devices is a wireless device, and wherein at least one of the first and the modified message presentation formats is in an HTML format.

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